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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/295,230 04/19/99 EWING

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EXAMINER

TM02/0827

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DIXON, T

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

08/27/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/295,230 | Applicant(s) EWING, CHRISTOPHER | |
| | Examiner Thomas A. Dixon | Art Unit 2161 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-24, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 7-9, 25 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The IDS submitted 10 May 1999 has been considered.

Drawings

2. The drawings have been objected by the Draftsperson, see attached form 948.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-4, 10-14, 16-24, 28, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Baron et al (5,809,481).

As per Claim 1.

Baron et al ('481) discloses:

- a) receiving from a first party a request to take an order for a gift to a second party, see column 9, lines 8-53 and column 2, line 66 – column 3, line 31;
- b) obtaining from said first party an identification of a gift to be sent to said second party, see column 3, lines 12-24;
- c) obtaining from said first party a pseudonym of said second party, see column 6, line 60 – column 7, line 21, and column 8, lines 1-50; and
- d) securing a non-pseudonymous name and address associated with said second party's pseudonym, see column 9, lines 35-52.

As per claim 2.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses issuing an order that said gift identified by said first party be sent to said second party's non-pseudonymous name and address, see column 9, lines 25-29 and lines 35-38.

As per claim 3.

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Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses securing said second party's non-pseudonymous name and address is carried out by looking up said second party's pseudonym in a database, see column 8, lines 1-20.

As per claim 4.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses securing a non-pseudonymous name and address associated with said second party's pseudonym is carried out by contacting said second party and requesting revelation of said second party's non pseudonymous name and address, see column 7, lines 22-47.

As per claim 10.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses said order is sent to a third party, see column 4, lines 11-21.

As per claim 11.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses said first party has the opportunity to reveal true identity information, see column 3, lines 1-3.

As per claim 12.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses said second party has the opportunity to reveal true identity information, see column 7, lines 22-48.

As per claim 13.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses charging said first party a fee, see column 5, lines 55-57 and column 6, lines 39-54.

As per claim 14.

Baron et al ('481) discloses all the limitations of claim 13.

Baron et al ('481) further discloses:

Baron et al ('481) does not specifically disclose charging the fee to said first party after the gift is sent, see column 5, lines 55-57 and column 6, lines 39-54.

As per claim 16.

Baron et al ('481) discloses all the limitations of claim 1

Baron et al ('481) further discloses charging said first party a fee, see column 5, lines 55-57 and column 6, lines 39-54.

As per claim 17.

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Baron et al ('481) discloses all the limitations of claim 16.

Baron et al ('481) further discloses fee is related to the value of the gift, see column 5, lines 55-57 and column 6, lines 39-54.

As per claim 18.

Baron et al ('481) discloses all the limitations of claim 1.

Baron et al ('481) further discloses the second party is charged a fee, see column 5, lines 55-57.

As per claim 19.

Baron et al ('481) discloses:

a) means for a first party to identify one's self, see column 9, lines 8-53 and column 2, line 66 – column 3, line 31;

b) means for said first party to identify a gift, see column 3, lines 12-24;

c) means for said first party to identify said second party by a pseudonym of said second party, see column 6, line 60 – column 7, line 21, and column 8, lines 1-50; and

d) means for determining said second party's true name and mail address from said pseudonym, see column 9, lines 35-52;

e) means for sending said identified gift to said second party in said second party's true name at said second party's true mailing address, see column 9, lines 35-38.

As per claim 20.

Baron et al ('481) discloses all the limitations of claim 19

Baron et al ('481) further discloses charging said first party a fee, see column 5, lines 55-57 and column 6, lines 39-54.

As per claim 21.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses means for enabling said second party to refuse a gift from said first party, see column 2, lines 29-32.

As per claim 22.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses means for enabling said second party to refuse a gift from said first party if said first party is identified by a pseudonym, see column 2, lines 29-32, and column 6, lines 39-47.

As per claim 23.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses means for enabling said second party to refuse a gift from said first party if said first partner is anonymous, see column 2, lines 29-32 and column 6, lines 39-47.

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As per claim 24.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses means for enabling said second party to refuse a gift from said first party if said first party is identified by a particular pseudonym or true name, see column 2, lines 29-32 and column 6, lines 39-47.

As per claim 26.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses enabling the second party to respond to the first party after delivery of a gift sent to said second party by said first party, see column 7, lines 22-47.

As per claim 28.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses enabling the first party to reveal or maintain confidentiality of said first party's true identity information, see column 6, lines 39-47.

As per claim 29.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) further discloses enabling the second party to reveal said second party's true identity information, see column 7, lines 22-47.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baron et al ('5,809,481).

As per claim 5.

Baron et al ('481) discloses all the limitations of claim 1.

Baron et al ('481) further discloses:

ii. storing said second party's preferences, if made, in said database in association with said second party's pseudonym or name and address, see column 7, lines 22-47.

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Baron et al ('481) does not specifically disclose:

i. giving said second party an opportunity to choose whether said second party will accept, or will not accept, attempted gifts addressed only to said second party's pseudonym.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to give the second party of Baron et al ('481) an opportunity within their preferences to choose whether said second party will accept, or will not accept, attempted gifts addressed only to said second party's pseudonym for the benefit of personal privacy.

As per claim 6.

Baron et al ('481) in view of Official Notice discloses all the limitations of claim 5

Baron et al ('481) further discloses checking said second party's stored preferences, see column 9, lines 8 –18, and column 7, line 22 – column 8, line 32.

As per claim 15.

Baron et al ('481) discloses all the limitations of claim 13.

Baron et al ('481) does not specifically disclose confirming receipt of said order before charging said fee to said first party.

Official Notice is taken that it is well known in the retail arts to confirm orders, see Stein (5,82,241), column 13, lines 6-9 as an example, before charging for a product or service for the benefit of accurate fulfillment of orders.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to confirm the order of the first party of Baron et al ('481) before charging for the service of providing a mailing list and promotional items for the benefit of accurate fulfillment of the order.

Allowable Subject Matter

5. Claims 7-9, 25, 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per claim 7.

Baron et al ('481) in view of Official Notice discloses all the limitations of claim 6

Baron et al ('481) does not specifically disclose if said second party's choice was to accept gifts addressed only to said second party's pseudonym, issuing an order that said gift identified by said first party be sent to said second party's non-pseudonymous name and address.

As per claim 8.

Baron et al ('481) in view of Official Notice discloses all the limitations of claim 6

Baron et al ('481) does not specifically disclose if said second party's choice was not to accept gifts addressed only to said second party's pseudonym, or if no choice was made, initiating means for preventing said gift identified by said first party be sent to said second party's non-pseudonymous name and address.

As per claim 9.

Baron et al ('481) in view of Official Notice discloses all the limitations of claim 8

Baron et al ('481) does not specifically disclose informing said first party that said second party's choice was to not accept gifts addressed only to said second party's pseudonym.

As per claim 25.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) does not specifically disclose the right to refuse a particular product-type.

As per claim 27.

Baron et al ('481) discloses all the limitations of claim 19.

Baron et al ('481) does not specifically disclose enabling said second party to respond to said first party after refusal of an attempted gift.

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Prior Art made of Record

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP0900684A to DIANNIPPON discloses a gift system, but does not disclose the system as claimed.

Burka discloses a database with identifiers, names and addresses, but does not disclose the system as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.



Thomas A. Dixon
Examiner
Art Unit 2161

August 23, 2001